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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,082	06/24/2004	Shuichi Kitamura	542-012.010	5847

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EXAMINER

BERNSHTEYN, MICHAEL

ART UNIT	PAPER NUMBER
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1713

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/500,082	Applicant(s) KITAMURA ET AL.	
	Examiner Michael Bernshteyn	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133); Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 13-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 13-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action follows a response filed on December 28, 2006. No claims have been amended, cancelled or added.
2. Claims 1, 3-11 and 13-19 are pending.

Claim Rejections - 35 USC § 102

3. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.

Claim Rejections - 35 USC § 103

4. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
5. Claims 1, 3-6, 11 and 13-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nishiguchi et al. (JP 09-324096), for rationale recited in paragraph 7 of Office Action dated on September 26, 2006.
6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiguchi'096 in view of Nishiguchi et al. (JP 10-060207), for rationale recited in paragraph 8 of Office Action dated on September 26, 2006.

Response to Arguments

7. Applicants traverse the rejection of claims 1, 3-9 and 11 under 35 U.S.C. 102(b) as being anticipated by, in the alternative, under 35 U.S.C. 103(a) as obvious over

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Nishiguchi et al. (JP 09-324096) and the rejection of claim 7 under 35 U.S.C. 103(a) as being unpatentable over Nishiguchi'096 in view of Nishiguchi et al. (JP 10-060207).

Applicant's arguments have been fully considered but they are not persuasive.

8. Applicants contend that the PVA film of Nishiguchi is different from the film of the present invention, because there are evidences that the T_g of the film in Nishiguchi is not lower than 20°C, which is out of the range in claim 1. This conclusion is based on the following observations: (1) the elongation values of the film samples in Nishiguchi are lower than that of the instant application. The elongation values of the Examples 1 to 6 of Nishiguchi are approximately 100%, only half of the values of the samples in the present application. This means the film samples of Nishiguchi are more rigid and brittle, and more susceptible to fractures caused by elastic or plastic deformation. Therefore, it is apparent that the T_g of these samples must be higher than the temperature under which the elongation is measured (20°C). (2) The hygroscopic property of the film samples of Nishiguchi also indicates that the T_g is not lower than 20°C. As shown in Table 2 of Nishiguchi, the hygroscopic property of all the film samples is "small" (<20%) (10th column of Table 2). The moisture absorption of all the film samples of Nishiguchi are small, that means these films were in a glassy state under the temperature the hygroscopic property was measured (25°C). Therefore, it is apparent that the T_g of the film samples of Nishiguchi must be not lower than 25°C (pages 3-4).

9. It is noted that the glass transition temperature is not the only factor, which influences on the elongation and the hydroscopic property. As it is mentioned in the

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specification, "the glass transition temperature of not more than 20⁰C can be achieved by suitably adjusting the kind and amount of the plasticizer, the degree of hydrolysis of the PVA resins, the heat treating temperature in the film formation, or the content of water of the films" (page 15, lines 16-20).

Nishiguchi'096 discloses in Example 2 a film formed from a composition comprising a mixture of **35 parts** of a modified PVA having saponification degree of **96.3%**, and **65 parts** of a modified PVA having saponification degree of **71.1%**, which is clearly within the claimed range. This film has mechanical strength, alkali-resistance, hygroscopy and crack resistance and has dissolution rate; it is suitable to encapsulate chemical products, (Table 1, page 4, [0038]-[0040]). Applicants discloses in Example 1 a film formed from a composition comprising a mixture of **40 parts** of a modified PVA having saponification degree of **98.5%**, and **60 parts** of a modified PVA having saponification degree of **72%**, which is very close to the prior art.

Therefore, in view of substantially identical polyvinyl alcohol composition between Nishiguchi and instant claim 1, it is the examiner position that Nishiguchi's polyvinyl alcohol composition inherently possesses the claimed properties. Since the USPTO does not have equipment to do the analytical test, the burden is now shifted to the applicant to prove otherwise. *In re Fitzgerald* 619 F 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980).

With regard to the limitation of the instant claim 1 concerning that "said film has a glass transition temperature of not more than 20⁰C", the rejection is also made in the sense of *In re Spada*, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990), which

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settles that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art.

10. Applicants contend that the current claim 1 is in fact the previous, now canceled, claim 2. Since the same claim (claim 2) was rejected twice based on two different references, the finality of the rejection is believed to be premature (MPEP 706.07). Withdrawal of finality of the rejection is respectfully requested.

11. It is noted that in the previous Office Action dated on September 26, 2006, the amended claim 1 was rejected based on a new reference JP 09-324096 and the previous argument regarding the rejection based on JP-A-43-1487 was moot in view of new ground(s) of rejection because in view of the amendment the scope of claim 1 was changed. Therefore, Applicant's amendment necessitated the new ground(s) of rejection, presented in the previous Office Action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bernshteyn whose telephone number is 571-272-2411. The examiner can normally be reached on M-F 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Bernshteyn
Patent Examiner
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03/08/2007



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